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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD B. ZALENSKI, DALE W. FRANK,
MICHAEL D. SORRENTI, and ALEXANDER GRINBERG

Appeal 2009-014783
Application 10/750,173
Technology Center 3700

Before TONI R. SCHEINER, DONALD E. ADAMS, and STEPHEN
WALSH, *Administrative Patent Judges*.

WALSH, *Administrative Patent Judge*.

DECISION ON APPEAL¹

This is an appeal under 35 U.S.C. § 134(a) involving claims to an implant device. The Patent Examiner rejected the claims on grounds of anticipation and obviousness. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Claims 1-7, 9, 11-13 and 15 are on appeal. Claim 1 is representative and reads as follows:

1. An implant device, comprising:
 - (i) a frame having a trigger mechanism;
 - (ii) an outer sleeve mechanically coupled to the frame;
 - (iii) an inner shaft having a grabber for mechanically engaging an implant, the inner shaft slidably disposed along a major axis of the inner shaft within the outer sleeve, whereby actuation of the trigger extends the grabber from the outer sleeve to thereby release the implant; and
 - (iv) a retaining element for directing the grabber toward a closed position whereby the grabber is substantially contained within the outer sleeve when the trigger is released.

The Examiner rejected the claims as follows:

- claims 1-7, 9, 11, 12 and 15 under 35 U.S.C. § 102(e) as anticipated by Markworth; and
- claim 13 under 35 U.S.C. § 103(a) as unpatentable over Markworth and Lim.

ANTICIPATION

The Issue

Appellants contend that “Markworth . . . discloses a different device that is configured in a way that is the diametric opposite of relevant claim elements.” (App. Br. 4.)

The issue with respect to this rejection is whether the Markworth device is configured as Appellants’ device is configured.

Principles of Law

“[U]nless a prior art reference discloses within the four corners of the document not only all of the limitations claimed but also all of the

limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008).

Analysis

We agree with Appellants that the rejection did not provide evidence that Markworth described the device defined by the appealed claims. Appellants have persuasively explained that: (1) Markworth did not describe the outer sleeve mechanically coupled to a frame as defined in claim element (ii) (App. Br. 10-11); (2) Markworth did not describe an inner shaft having a grabber as defined in claim element (iii) (*id.* at 11-12); (3) Markworth did not describe an inner shaft slidably disposed within an outer sleeve as defined in claim element (iii) (*id.* at 12); and (4) rather than describing extension of a grabber by trigger actuation, Markworth described the opposite (*id.* at 13-14). Because Markworth did not describe all the elements arranged as claimed, we must reverse this rejection.

OBVIOUSNESS

The obviousness rejection of claim 13 relied on the same findings concerning Markworth’s device that we found insufficient as a description of the claimed device. The obviousness rejection did not account for all the differences between Markworth’s device and the claimed device, and we must therefore reverse it.

SUMMARY

We reverse the rejection of claims 1-7, 9, 11, 12 and 15 under 35 U.S.C. § 102(e) as anticipated by Markworth.

Appeal 2009-014783
Application 10/750,173

We reverse the rejection of claim 13 under 35 U.S.C. § 103(a) as unpatentable over Markworth and Lim.

REVERSED

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